

REMARKS

This is a full and timely response to the outstanding Office action mailed April 16, 2004. Upon entry of the amendments in this response claims 1-49 are pending. More specifically, claims 1, 23, and 49 are amended. These amendments are specifically described hereinafter. It is believed that the foregoing amendments add no new matter to the present application.

I. Present Status of Patent Application

Claims 1-49 are rejected under 35 U.S.C. 102(e) as being anticipated by Gilmour *et al.* (U.S. Patent No. 6,640,229).

II. Examiner Interview

Applicant first wishes to express his sincere appreciation for the time that Examiner Kianersi spent with Applicant's Attorneys during a July 15th telephone discussion regarding the above-identified Office Action. Applicant believes that certain important issues regarding the Gilmour reference, the claim language regarding the instruction in the email, and the application of the instruction to email were identified during the telephone discussion, and that they are resolved herein. During that conversation, Examiner Kianersi seemed to indicate that it would be potentially beneficial for Applicant to file this amendment and response. Thus, Applicant respectfully requests that Examiner Kianersi carefully consider this amendment and response.

III. Miscellaneous Issues

Claims 1, 23, and 49 were amended to clarify that the instruction is being applied to an email message. In contrast, claims 38 and 44 clearly claim that the instructions are applied to the email message and no amendment for the purpose of clarification is necessary. For this reason, Applicant requests that the next Office Action be non-final.

IV. Rejections Under 35 U.S.C. §102(b)

A. Claims 1-22

The Office Action rejects claims 1-22 under 35 U.S.C. 102(e) as being anticipated by Gilmour *et al.* (U.S. Patent No. 6,640,229). For the reasons set forth below, Applicant respectfully traverses the rejection.

Independent claim 1 recites:

1. A method for managing a predetermined set of email messages on a source email server from a remote email network, said method comprising the steps of:

(a) receiving an email message at the source email server, wherein said email message has a destination email address in a first field, a code in a second field and an instruction in a third field, wherein said destination email address corresponds to a subscriber account on the remote email network;

(b) checking a database to determine a permission for the destination email address; and

(c) ***applying the instruction to the set of email messages if the permission is granted.***

For a proper rejection of a claim under 35 U.S.C. §102, the cited reference must disclose, teach, or suggest all elements/features/steps of the claim at issue. *See, e.g., E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430, 7 U.S.P.Q.2d 1129 (Fed. Cir. 1988).

Applicant respectfully submits that independent claim 1 as amended is allowable for at least the reason that Gilmour does not disclose, teach, or suggest at least **applying the instruction to the set of email messages if the permission is granted**. In Gilmour, the instruction is applied to other data in a database, not to a set of emails as claimed. Applicant respectfully submits that Gilmour does not disclose an email message with an instruction in a third field and applying the instruction to a set of email messages. As provided by the Office

Action, *Gilmour* discloses that “a determination may be made as to whether a match occurred against any further terms responsive to a query.” See *Gilmour*, col. 32, lines 26-36. However, this describes data that is entered in an email and a query, or an instruction, not contained in the email, that is performed on the data contained in the email. Conversely, in the instant claim, the instruction is a field in the email message and it is applied to a set of email messages.

Notwithstanding, the undersigned has reviewed the entirety of *Gilmour* and has failed to identify any such teaching anywhere within this reference. Therefore, *Gilmour* does not anticipate claim 1, and the rejection should be withdrawn.

Because independent claim 1 is allowable over the prior art of record, dependent claims 2-22 (which depend from independent claim 1) are allowable as a matter of law for at least the reason that dependent claims 2-22 contain all the steps/features of independent claim 1. See *Minnesota Mining and Manufacturing Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002); *Jeneric/Pentron, Inc. v. Dillon Co.*, 205 F.3d 1377, 54 U.S.P.Q.2d 1086 (Fed. Cir. 2000); *Wahpeton Canvas Co. v. Frontier Inc.*, 870 F.2d 1546, 10 U.S.P.Q.2d 1201 (Fed. Cir. 1989). Therefore, since dependent claims 2-22 are patentable over *Gilmour*, the rejection to claims 2-22 should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 1, dependent claims 2-22 recite further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the prior art of record. Hence there are other reasons why dependent claims 2-22 are allowable.

B. Claims 23-37

The Office Action rejects claims 23-37 under 35 U.S.C. 102(e) as being anticipated by *Gilmour et al.* (U.S. Patent No. 6,640,229). For the reasons set forth below, Applicant respectfully traverses the rejection.

Independent claim 23 recites:

23. A method for managing a predetermined set of email messages on a source email server from a remote email network, said method comprising the steps of:

- (a) populating a database with subscriber email addresses corresponding to subscriber accounts authorized to remotely manage email messages;
- (b) receiving an email message at the source email server, wherein said email message has a destination email address in a first field, a code in a second field and an instruction in a third field, wherein said destination email address corresponds to a subscriber account on the remote email network;
- (c) checking the database to determine a permission for the destination email address; and
- (d) ***applying the instruction to the set of email messages if the permission is granted.***

For a proper rejection of a claim under 35 U.S.C. §102, the cited reference must disclose, teach, or suggest all elements/features/steps of the claim at issue. *See, e.g., E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430, 7 U.S.P.Q.2d 1129 (Fed. Cir. 1988).

Applicant respectfully submits that independent claim 23 as amended is allowable for at least the reason that *Gilmour* does not disclose, teach, or suggest at least **applying the instruction to the set of email messages if the permission is granted**. In *Gilmour*, the instruction is applied to other data in a database, not to a set of emails as claimed. Applicant respectfully submits that *Gilmour* does not disclose an email message with an instruction in a third field and applying the instruction to a set of email messages. As provided by the Office Action, *Gilmour* discloses that “a determination may be made as to whether a match occurred against any further terms responsive to a query.” *See Gilmour*, col. 32, lines 26-36. However, this describes data that is entered in an email and a query, or an instruction, not contained in the email, that is performed on the data contained in the email. Conversely, in the instant claim, the instruction is a field in the email message and it is applied to a set of email messages.

Notwithstanding, the undersigned has reviewed the entirety of *Gilmour* and has failed to identify any such teaching anywhere within this reference. Therefore, *Gilmour* does not anticipate claim 23, and the rejection should be withdrawn.

Because independent claim 23 is allowable over the prior art of record, dependent claims 24-37 (which depend from independent claim 23) are allowable as a matter of law for at least the reason that dependent claims 24-37 contain all the steps/features of independent claim 23. See *Minnesota Mining and Manufacturing Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002); *Jeneric/Pentron, Inc. v. Dillon Co.*, 205 F.3d 1377, 54 U.S.P.Q.2d 1086 (Fed. Cir. 2000); *Wahpeton Canvas Co. v. Frontier Inc.*, 870 F.2d 1546, 10 U.S.P.Q.2d 1201 (Fed. Cir. 1989). Therefore, since dependent claims 24-37 are patentable over *Gilmour*, the rejection to claims 24-37 should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 23, dependent claims 24-37 recite further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the prior art of record. Hence there are other reasons why dependent claims 24-37 are allowable.

C. Claims 38-43

The Office Action rejects claims 38-43 under 35 U.S.C. 102(e) as being anticipated by *Gilmour et al.* (U.S. Patent No. 6,640,229). For the reasons set forth below, Applicant respectfully traverses the rejection.

Independent claim 38 recites:

38. A method for remotely retrieving a first email message from a source email server to a destination email address having a standard email client application, said method comprising the steps of:

- (a) populating a database with subscriber email addresses corresponding to subscriber accounts authorized to remotely retrieve email messages;

- (b) receiving a second email message on the source server, wherein said second email message has the destination address in a message sender field and a code in a predetermined field;
- (c) checking the database to verify the destination email address as an authorized account; and
- (d) ***sending, in response to the code, the first email message from the source email server to the destination email address.***

For a proper rejection of a claim under 35 U.S.C. §102, the cited reference must disclose, teach, or suggest all elements/features/steps of the claim at issue. *See, e.g., E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430, 7 U.S.P.Q.2d 1129 (Fed. Cir. 1988).

Applicant respectfully submits that independent claim 38 is allowable for at least the reason that *Gilmour* does not disclose, teach, or suggest at least **sending in response to the code, the first email message from the source email server to the destination address**. In *Gilmour*, the code is applied to other data in a database, not to an email on a source email server as claimed. Applicant respectfully submits that *Gilmour* does not disclose an email message with a code in a predetermined field and sending in response to the code, the first email message from the source email server to the destination address. As provided by the Office Action, *Gilmour* discloses that “a determination may be made as to whether a match occurred against any further terms responsive to a query.” *See Gilmour*, col. 32, lines 26-36. However, this describes data that is entered in an email and a query, or a code, not contained in the email, that is performed on the data contained in the email. Conversely, in the instant claim, the code is a field in the email messages.

Notwithstanding, the undersigned has reviewed the entirety of *Gilmour* and has failed to identify any such teaching anywhere within this reference. Therefore, *Gilmour* does not anticipate claim 38, and the rejection should be withdrawn.

Because independent claim 38 is allowable over the prior art of record, dependent claims 39-43 (which depend from independent claim 38) are allowable as a matter of law for at least the reason that dependent claims 39-43 contain all the steps/features of independent claim 38. *See*

Minnesota Mining and Manufacturing Co. v. Chemque, Inc., 303 F.3d 1294, 1299 (Fed. Cir. 2002) *Jeneric/Pentron, Inc. v. Dillon Co.*, 205 F.3d 1377, 54 U.S.P.Q.2d 1086 (Fed. Cir. 2000); *Wahpeton Canvas Co. v. Frontier Inc.*, 870 F.2d 1546, 10 U.S.P.Q.2d 1201 (Fed. Cir. 1989). Therefore, since dependent claims 39-43 are patentable over *Gilmour*, the rejection to claims 39-43 should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 38, dependent claims 39-43 recite further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the prior art of record. Hence there are other reasons why dependent claims 39-43 are allowable.

D. Claims 44-48

The Office Action rejects claims 44-48 under 35 U.S.C. 102(e) as being anticipated by *Gilmour et al.* (U.S. Patent No. 6,640,229). For the reasons set forth below, Applicant respectfully traverses the rejection.

Independent claim 44 recites:

44. A method for remotely managing a first email message on a source email server from an email account on a remote email server, said method comprising the steps of:

- (a) receiving a second email message on the source server, wherein said second email message has a code in a first predetermined field;
- (b) checking a database for a subscriber account corresponding to a message sender field in the second email message; and
- (c) *processing the first email message according to an instruction in a second predetermined field.*

For a proper rejection of a claim under 35 U.S.C. §102, the cited reference must disclose, teach, or suggest all elements/features/steps of the claim at issue. *See, e.g., E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430, 7 U.S.P.Q.2d 1129 (Fed. Cir. 1988).

Applicant respectfully submits that independent claim 44 is allowable for at least the reason that *Gilmour et al* does not disclose, teach, or suggest at least **processing the first email message according to an instruction in a second predetermined field**. In *Gilmour*, the instruction is applied to other data in a database, not to an email as claimed.

Applicant respectfully submits that *Gilmour* does not disclose an email message with an instruction and processing an email message according to the instructions. As provided by the Office Action, *Gilmour* discloses that “a determination may be made as to whether a match occurred against any further terms responsive to a query.” *See Gilmour*, col. 32, lines 26-36. However, this describes data that is entered in an email and a query, or an instruction, not contained in the email, is performed on the data contained in the email. Conversely, in the instant claim, the instruction is a field in the email message and an email message is processed according to the instruction.

Notwithstanding, the undersigned has reviewed the entirety of *Gilmour* and has failed to identify any such teaching anywhere within this reference. Therefore, *Gilmour* does not anticipate claim 44, and the rejection should be withdrawn.

Because independent claim 44 is allowable over the prior art of record, dependent claims 45-48 (which depend from independent claim 44) are allowable as a matter of law for at least the reason that dependent claims 45-48 contain all the steps/features of independent claim 44. *See Minnesota Mining and Manufacturing Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002) *Jeneric/Pentron, Inc. v. Dillon Co.*, 205 F.3d 1377, 54 U.S.P.Q.2d 1086 (Fed. Cir. 2000); *Wahpeton Canvas Co. v. Frontier Inc.*, 870 F.2d 1546, 10 U.S.P.Q.2d 1201 (Fed. Cir. 1989). Therefore, since dependent claims 45-48 are patentable over *Gilmour*, the rejection to claims 45-48 should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 44, dependent claims 45-48 recite further features and/or combinations of features, as are

apparent by examination of the claims themselves, that are patently distinct from the prior art of record. Hence there are other reasons why dependent claims 45-48 are allowable.

E. Claim 49

The Office Action rejects claim 49 under 35 U.S.C. 102(e) as being anticipated by Gilmour *et al.* (U.S. Patent No. 6,640,229). For the reasons set forth below, Applicant respectfully traverses the rejection.

Independent claim 49 recites:

49. A system for managing a predetermined set of email messages on a source email server from a remote email network, said system comprising:

(a) a registration database on the source server, said registration database comprising a local subscriber account on said source server and an associated destination email address on the remote email network;

(b) a first module on the source email server, wherein when a first email message having a code in a first field, an instruction in a second field of the first email message and a sender email address in a sender field is received on the source email server, said first module determines if the sender email address is in the database; and

(c) *a second module on the source server, wherein if the sender email address is in the database, the second module applies the instruction to the set of email messages.*

For a proper rejection of a claim under 35 U.S.C. §102, the cited reference must disclose, teach, or suggest all elements/features/steps of the claim at issue. *See, e.g., E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430, 7 U.S.P.Q.2d 1129 (Fed. Cir. 1988).

Applicant respectfully submits that independent claim 49 as amended is allowable for at least the reason that *Gilmour* does not disclose, teach, or suggest at least **applying the instruction to the set of email messages**. In *Gilmour*, the instruction is applied to other data in a database, not to a set of emails as claimed. Applicant respectfully submits that *Gilmour* does not disclose an email message with an instruction in a second field and performing the instruction on a set of email messages. As provided by the Office Action, *Gilmour* discloses that “a determination may be made as to whether a match occurred against any further terms responsive to a query.” See *Gilmour*, col. 32, lines 26-36. However, this describes data that is entered in an email and a query, or an instruction, not contained in the email, that is performed on the data contained in the email. Conversely, in the instant claim, the instruction is a field in the email message and it is applied to a set of email messages.

Notwithstanding, the undersigned has reviewed the entirety of *Gilmour* and has failed to identify any such teaching anywhere within this reference. Therefore, *Gilmour* does not anticipate claim 49, and the rejection should be withdrawn.

V. Prior References Made of Record

The prior references made of record have been considered, but are not believed to affect the patentability of the presently pending claims. Other statements not explicitly addressed herein are not admitted.

CONCLUSION

For at least the reasons set forth above, Applicant respectfully submits that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the now pending claims 1-49 are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned agent at (770) 933-9500.

Respectfully submitted,



Jeffrey R. Kuester, Reg. No. 34,367

**THOMAS, KAYDEN,
HORSTEMEYER & RISLEY, L.L.P.**
Suite 1750
100 Galleria Parkway N.W.
Atlanta, Georgia 30339
(770) 933-9500